

## REMARKS

Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, and 17-36 are pending in the application. Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 19, 20 and 23-28 are amended herein. Claims 2, 4, 6, 8, 10, 12 and 16 are cancelled herein without prejudice or disclaimer. New claims 32-36 are added herein. Support for the amendments to the claims, and the new claims, may be found in the claims as originally filed. New claims 32-36 are thus believed to be within the scope of the elected embodiments. Reconsideration is requested based on the foregoing amendment and the following remarks.

### **Claim Rejections - 35 U.S.C. § 112:**

The Specification was rejected under 35 U.S.C. § 112, first paragraph, as not written in "full, clear, concise, and exact terms." The specification was amended to address the rejection. Withdrawal of the rejection is earnestly solicited.

### **Claim Rejections - 35 U.S.C. § 112:**

Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17 and 23-28 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 19, 20 and 23-28 were amended to make them more definite. Withdrawal of the rejection is earnestly solicited.

### **Claim Rejections - 35 U.S.C. § 101:**

Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The rejection is traversed.

The Office Action sets forth a "two-prong" test for statutory subject matter at page 4, the first prong of which is a so-called "technological arts" test. The Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, however, has made clear in Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005), that there is no technological arts tests for statutory subject matter. In particular, as stated in Lundgren,

"Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection cannot be sustained."

There is thus no need for claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 to be "within the technological art," contrary to the assertion at page 4 of the Office Action. 35 U.S.C. § 101, rather, which governs the meaning of "statutory subject matter," provides only,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, as provided in State Street Bank and Trust Co. v. Signature Financial Group Inc. (149 F. 3d 1368, 1375 (Fed.Circ. 1998)),

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Since claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 do produce a useful, concrete, tangible result, i.e. reservations, claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 are directed to statutory subject matter within the provisions of State Street.

Furthermore, as provided in State Street,

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶2.

Since claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 do fall within one of the four stated categories of statutory subject matter, claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 are directed to statutory subject matter within the provisions of State Street.

In particular, claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 recite a reservation server or a user terminal, both of which fall at least within the "machine" or "manufacture" categories of statutory subject matter provided for by 35 U.S.C. § 101.

Furthermore, as provided in State Street,

The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

Since Congress intended § 101 to extend to "anything under the sun that is made by man", claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 must have been directed to statutory subject matter within the provisions of State Street. Finally, as provided in State Street,

Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("We have also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)).

Since it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations, the further requirements listed at pages 4 and 5 of the Office Action are unlawful and ought to be withdrawn. Claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 are thus submitted be directed to statutory subject matter. Withdrawal of the rejection of claims 1, 3, 5, 7, 9, 11, 13, 14, 15, 17, 23, 24, and 25 is earnestly solicited.

#### **Claim Rejections - 35 U.S.C. § 102:**

Claims 1, 7, 17, 18, and 23-26 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,876,973 to Visconti (hereinafter "Visconti"). The rejection is traversed to the extent it would apply to the claims as amended.

Claim 1 recites,

"alternative event information."

Visconti neither teaches, discloses, nor suggests "alternative event information," as recited in claim 1. Visconti, rather, describes only computing the next available *time* for a *particular* event in the Abstract, not "alternative event information," contrary to the assertion in the Office Action. As described in the Abstract of Visconti, rather:

If there is no match, then an automated arithmetic process computes the next available time and submits that to the patron in the interactive process.

Thus, in Visconti, available times for a given event are provided to the user. This is to be contrasted with claim 1, in which "alternative event information" *itself* it provided.

Claim 1 recites further,

"second alternative event information, which is different from the reservation-needed service and the first alternative event information and is practicable for a user of the user terminal."

Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above, let alone "second alternative event information, which is different from the reservation-needed service and the first alternative event information and is practicable for a

user of the user terminal." Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 7, 17 and 18 depend from claim 1 and add further distinguishing elements. Claims 7, 17 and 18 are thus also submitted to be allowable. Withdrawal of the rejection of claims 7, 17 and 18 is also earnestly solicited.

Claims 23 and 24:

Claim 23 recites,

"alternative event information."

Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above with respect to the rejection of claim 1.

Claim 23 recites further,

"second alternative event information, which is different from the reservation-needed service and the first alternative event information."

Visconti neither teaches, discloses, nor suggests "second alternative event information, which is different from the reservation-needed service and the first alternative event information," as discussed above with respect to the rejection of claim 1. Claim 23 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 23 is earnestly solicited.

Claim 24 depends from claim 23 and adds further distinguishing elements. Claim 24 is thus also submitted to be allowable. Withdrawal of the rejection of claim 24 is also earnestly solicited.

Claim 25:

Claim 25 recites,

"alternative event information."

Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above with respect to the rejection of claim 1.

Claim 25 recites further,

"second alternative event information, which is different from the reservation-needed service and the first alternative event information."

Visconti neither teaches, discloses, nor suggests "second alternative event information, which is different from the reservation-needed service and the first alternative event information and is practicable for a user of the user terminal," as discussed above with respect to the rejection of claim 1. Claim 25 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 25 is earnestly solicited.

Claim 26:

Claim 26 recites,

"alternative event information."

Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above with respect to the rejection of claim 1.

Claim 26 recites further,

"second alternative event information, which is different from the reservation-needed service and the first alternative event information."

Visconti neither teaches, discloses, nor suggests "second alternative event information, which is different from the reservation-needed service and the first alternative event information," as discussed above with respect to the rejection of claim 1. Claim 26 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 26 is earnestly solicited.

**Claim Rejections - 35 U.S.C. § 103:**

Claims 3, 5, 9, 11, 15, 27, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Visconti in view of U.S. Patent No. 5,978,770 to Waytena et al. (hereinafter "Waytena"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 3, 5, 9, 11, and 15 depend from claim 1 and add further distinguishing elements. Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above, let alone "second alternative event information, which is different from the reservation-needed service and the first alternative event information," as discussed above with respect to the rejection of claim 1. Waytena does not either, and thus cannot make up for the deficiencies of Visconti with respect to claims 3, 5, 9, 11, and 15.

Finally, the Office Action provides no motivation or suggestion to combine the teachings

of Visconti and Waytena, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the assertion at page 6 that:

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator for the benefit of allowing the user to fit it into the itinerary.

Visconti, however, already computes the next available time for a particular event, as discussed above. Knowledge of the next available time at which an event will take place *implies* the time one needs to wait for the event. There would thus have been no motivation at the time of the invention for persons of ordinary skill in the art to have modified Visconti, as proposed in the Office Action, because Visconti already computes the next available time for a particular event. Claims 3, 5, 9, 11, and 15 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3, 5, 9, 11, and 15 is also earnestly solicited.

Claims 27 and 28:

Claims 27 and 28 depend from claim 26 and add further distinguishing elements. Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above, let alone "second alternative event information, which is different from the reservation-needed service and the first alternative event information," as discussed above with respect to the rejection of claim 1. Waytena does not either, and thus cannot make up for the deficiencies of Visconti with respect to claims 27 and 28.

Finally, the Office Action provides no motivation or suggestion to combine the teachings of Visconti and Waytena, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the assertion at page 10 that:

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to have a wait time calculator for the benefit of allowing the user to fit it into the itinerary.

Visconti, however, already computes the next available time for a particular event, as discussed above. Knowledge of the next available time at which an event will take place *implies* the time one needs to wait for the event. There would thus have been no motivation at the time of the invention for persons of ordinary skill in the art to have modified Visconti, as proposed in the Office Action, because Visconti already computes the next available time for a particular event. Claims 27 and 28 are thus also submitted to be allowable. Withdrawal of the rejection of claims 27 and 28 is also earnestly solicited.

Claim 19:

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Visconti in view of U.S. Patent No. 5,712,979 to Graber et al. (hereinafter "Graber") or U.S. Patent No. 5,359,508 to Rossides (hereinafter "Rossides"). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 19 depends from claim 1 and add further distinguishing elements. Visconti neither teaches, discloses, nor suggests "alternative event information," as discussed above, let alone "second alternative event information, which is different from the reservation-needed service and the first alternative event information," as discussed above with respect to the rejection of claim 1. Neither Graber nor Rossides do either, and thus cannot make up for the deficiencies of Visconti with respect to claim 19. Claim 19 is thus also submitted to be allowable. Withdrawal of the rejection of claim 19 is also earnestly solicited.

**Allowable Subject Matter:**

The Applicant acknowledges with appreciation the indication that claims 13 and 14 contain allowable subject matter. Claims 13 and 14 have consequently been placed in independent form.

**New claims 32-36:**

Claims 32 and 35 recite,

"a transmitting section for transmitting, through a radio network, the store information retained in said retaining section to a user terminal which is present in a specified area (hereinafter will be called the first specified area) whose base point is the reservation server."

None of the cited references disclose "a transmitting section for transmitting, through a radio network, the store information retained in said retaining section to a user terminal which is present in a specified area (hereinafter will be called the first specified area) whose base point is the reservation server." Claim 32 and 35 are thus submitted to be allowable.

Claims 33 and 34 depend from claim 32 and add further distinguishing elements. Claims 33 and 34 are thus also submitted to be allowable. Withdrawal of the rejection of claims 33 and 34 is also earnestly solicited.

Claim 36:

Claim 36 recites,

"alternative event information."

None of the cited references disclose "alternative event information." Claim 36 is thus submitted to be allowable.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3, 5, 7, 9, 11, 13, 14, 15, and 17-36 are allowable over the cited references. Allowance of all claims 1, 3, 5, 7, 9, 11, 13, 14, 15, and 17-36 and of this entire application is therefore respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

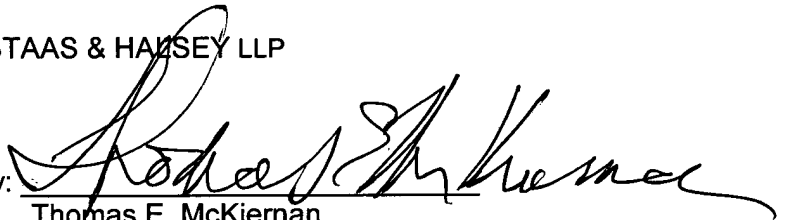
Respectfully submitted,

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